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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,486	11/13/2003	David A. Schechter	2876	8330
50855	7590	11/10/2005		
UNITED STATES SURGICAL, A DIVISION OF TYCO HEALTHCARE GROUP LP 150 GLOVER AVENUE NORWALK, CT 06856			EXAMINER TOY, ALEX B	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 11/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/712,486	<b>Applicant(s)</b> SCHECHTER ET AL.	
	<b>Examiner</b> Alex B. Toy	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 9-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7 and 8 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/17/04; 8/26/04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: IDS: 5/11/05

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Species I shown in Fig. 2 in the reply filed on October 24, 2005 is acknowledged. Claims 6, 9, and 14-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species II-VI, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 24, 2005.

Applicant submits that claims 1-5, 7-8, and 10-13 read on the elected Species I. The Office, however, maintains that claim 10 and the depending claims 11-13 are drawn to the non-elected Species II shown in Fig. 3. Therefore, claims 10-13 are also withdrawn.

In summary, claims 6 and 9-20 are withdrawn from further consideration. Claims 1-5 and 7-8 are examined. Claims 1-3 and 8 are acknowledged to be generic.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the at least one jaw member including a plurality of electrodes across the width thereof with a sensor must be shown or the features canceled from claim 7. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

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prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claim 8 is objected to because of the following informalities: Claim 8 specifies "the compressible material" but lacks antecedent basis in claim 8 or independent claim 1. For the purposes of examination, it is assumed that applicant intended "the compressible material" to be "the elastomeric material." Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Hooven (U.S. Pat. No. 6,086,586).

Regarding claim 1, Hooven discloses an electrosurgical instrument for sealing tissue, comprising:

a housing 14 having a shaft 28 attached thereto (Fig. 2); and

an end effector 22, 24 assembly attached to a distal end of the shaft, the end effector assembly including first 22 and second 24 jaw members attached thereto, the jaw members being movable relative to one another from a first position for approximating tissue to at least one additional position for grasping tissue therebetween (Figs. 2, 4c, and 6);

each of the jaw members including an elastomeric material 50, 52 disposed on an inner facing tissue contacting surface thereof, each of the elastomeric materials including an electrode 42, 44, 46, 48 disposed therein, the electrodes being offset a distance X relative to one another such that when the jaw members are closed about the tissue and when the electrodes are activated, electrosurgical energy flows through the tissue in a generally coplanar manner relative to the tissue contacting surfaces (col. 4, ln. 30-34 and Figs. 5-6 and 9).

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Regarding claim 2, Hooven discloses the electrosurgical instrument of claim 1, wherein the elastomeric material 50, 52 is ABS (col. 4, ln. 46-49).

Regarding claim 3, Hooven discloses the electrosurgical instrument of claim 1, wherein the offset distance X is in the range of about 0.005 inches (0.127 mm) to about 0.200 inches (5.08 mm) (col. 4, ln. 63-65 and Fig. 9).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4-5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hooven ('586) in view of Klicek (U.S. Pat. No. 5,496,312).

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Hooven discloses the electrosurgical instrument of claim 1, wherein at least one of the jaw members 22, 24 includes a plurality of electrodes 42, 44, 46, 48 across the width thereof (Figs. 5-6). The claims differ from Hooven in calling for a sensor that measures at least one of tissue impedance, tissue temperature, and tissue thickness to regulate the applied electrosurgical energy by selecting one of the plurality of electrodes for electrically opposing the electrode disposed on the other of the jaw members.

Klicek, however teaches a bipolar electrosurgical instrument with multiple electrodes 18, comprising at least one impedance or temperature sensor 19, 23, which provides information to a feedback circuit for regulating the applied electrosurgical energy by selecting one of the plurality of electrodes for electrically opposing the electrode disposed on the other of the jaw members (col. 5, ln. 50-54, col. 6, ln. 4-39, and Figs. 3 and 6). This allows the instrument of Klicek to recognize variations in tissue impedance and temperature in closely located tissues and accommodate those variations with automatic control that responds independently to the tissue at each active electrode contact.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the instrument of Hooven in accordance with claims 4-5 and 7 in view of the teachings of Klicek in order to allow finer control of the amount of applied electrosurgical energy. Using the sensor/control system of Klicek would allow the user of the Hooven instrument to activate only one of the two opposing electrode pairs to better control the intensity and rate of treatment based on the tissue type.

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Claim 8 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hooven ('586).

Regarding claim 8, Hooven discloses the electrosurgical instrument of claim 1, wherein the elastomeric material has a comparative tracking index value of about 300 to about 600 volts. Since the elastomeric material of Hooven (see rejection of claim 2) is identical to applicant's disclosed elastomeric material, they are deemed to inherently, or at least obviously, possess the same comparative tracking index value.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US 5443463 A	USPAT	Stern; Roger A. et al.
US 5810811 A	USPAT	Yates; David C. et al.
US 20040236325 A1	US-PGPUB	Tetzlaff, Philip M. et al.
US 6932816 B2	USPAT	Phan; Huy D.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex B. Toy whose telephone number is (571) 272-1953. The examiner can normally be reached on Monday through Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AT *AT*  
11/1/05

*Michael Peffley*  
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PRIMARY EXAMINER